

REMARKS

The new grounds of rejection require a minimum of *four* references to even arguably make a *prima facie* case for obviousness. Applicant respectfully requests reconsideration of this rejection in light of the clear failure to make out a *prima facie* case of obviousness.

The recent Supreme Court decision of *KSR v. Teleflex*, 127 S. Ct. 1727, 1740-41 (2007) reaffirmed that an invention incorporating known parts must still be judged according to the law set forth at 35 U.S.C. § 103. Although the Supreme Court recently cautioned that an invention combining known elements is “likely to be obvious when it does no more than yield predictable results,” it more importantly acknowledged the undeniable reality that “inventions in most, if not all, instances rely upon combinations of what, in some sense, is already known.” *KSR*, 127 S. Ct. 1727, 1740-41 (2007). Thus, before deciding whether prior art renders a claimed invention obvious, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements.” *KSR*, 127 S. Ct. at 1741.

As a corollary, “when the prior art *teaches away* from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR*, 127 S. Ct. at 1740. And when previously known elements “work[] together in an unexpected and fruitful manner,” the invention comprising them is unlikely to be “obvious.” *KSR*, 127 S. Ct. at 1740. That the cited art “teaches away” from the claimed invention is strong evidence showing nonobviousness of the claims. *Monarch Knitting Machinery Corp.*, 139 F.3d at 885. As but one example, the Examiner notes that the combination of Bennett and Gulick *teach terminating a data packet*. The claim requires exactly the opposite, namely, the ‘providing of tag bits set to a unique value indicative of an overrun condition, *but not terminating*, data that overruns the buffer’. This diametrically

opposite teaching can not be filled in by yet third and fourth references. The 'primary' references teach away and support the conclusion of patentability.

The Supreme Court warns against "the distortion caused by hindsight bias" when evaluating patent validity challenges and urges caution with "arguments reliant on *ex post* reasoning." *KSR*, 127 S. Ct. at 1742. Any prior art asserted to render the invention obvious must be scrutinized from the proper timeframe. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Clearly, applicants claim has been used as a guide to pick and choose the *four* references required to even assert obviousness of the pending claims. Again, this is compelling evidence of non-obviousness.

Applicants respectfully request reconsideration. In the event that further discussion is required, Applicant would request that the undersigned be contacted such that we can arrange a telephonic interview with the inventor.

Respectfully submitted,

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